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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,951	09/18/2003	James McSwiggen	MBHB02-742-F (400.131)	8325
20306	7590	06/21/2006	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP			BOWMAN, AMY HUDSON	
300 S. WACKER DRIVE			ART UNIT	
32ND FLOOR			PAPER NUMBER	
CHICAGO, IL 60606			1635	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/665,951

Applicant(s)

MCSWIGGEN ET AL.

Examiner

Amy H. Bowman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/22/04, 10/14/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Application/Amendment/Claims***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 4/11/2006 has been entered.

Rejections and/or objections not reiterated from the previous office action mailed 10/19/2005 are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

The rejections under 35 U.S.C. 102 and 35 U.S.C. 103 of the office action mailed 10/19/2005 are considered moot in view of the instant claim amendment inserting SEQ ID NO: 2456 as the target sequence.

Claims 36-56 are pending in the application.

### ***New Objections/Rejections***

#### ***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

In the instant case, the effective filing date of the instant claims is determined to be that of the instant application, 10/665,951, which has an effective filing date of 9/18/2003. The instant claims of application 10/665,951 do not receive the benefit of any of the earlier filed priority documents because none of the documents teach a method of cleaving RNA comprising SEQ ID NO: 2456 encoded by a mammalian VEGFr1 gene. It is noted that instant SEQ ID NO: 2456 is disclosed on page 138 of the instant specification as being a primer sequence. None of the priority documents, or the instant specification, disclose targeting a primer sequence for the cleavage of RNA encoded by the mammalian VEGFr1 gene. Thus, the instant claims are accorded an effective filing date of 9/18/03.

### ***Sequence Compliance***

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37

CFR 1.821 through 1.825 because there are sequences in the specification that are not in the sequence listing and therefore cannot be searched. For example, SEQ ID NO: 2456, recited in instant claim 36 and disclosed on page 138 of the instant specification is not in the CRF.

A complete response to this office action must correct the defects cited above regarding compliance with the sequence rules and a response to the action on the merits which follows.

The aforementioned instance of failure to comply is not intended as an exhaustive list of all such potential failures to comply in the instant application. Applicants are encouraged to thoroughly review the application to ensure that the entire application is in full compliance with all sequence rules. This requirement will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Instant claim 36 recites SEQ ID NO: 2456, which is disclosed as a primer specific for VEGFR-1 (see page 138 of the instant specification). Instant claim 36 is drawn to a method of cleaving RNA comprising SEQ ID NO: 2456 encoded by a mammalian

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VEGFr1 gene comprising contacting a double-stranded nucleic acid molecule with the RNA encoded by VEGFr1 gene. It is unclear how contacting a double-stranded nucleic acid molecule with SEQ ID NO: 2456, a primer, will result in cleavage of the RNA encoded by the mammalian VEGFr1 gene, SEQ ID NO: 2456.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36-56 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant invention is drawn to a method of cleaving RNA comprising SEQ ID NO: 2456 encoded by a mammalian VEGFr1 gene comprising contacting a double-stranded nucleic acid molecule with the RNA encoded by VEGFr1 gene under conditions suitable for cleavage of the RNA encoded by the mammalian VEGFr1 gene.

Applicant has not described or contemplated targeting a primer specific for VEGFr1, SEQ ID NO: 2456, to achieve cleavage of SEQ ID NO: 2456. The instant specification does not contemplate targeting a portion of the antisense transcribed RNA.

Therefore, applicant has not described the invention in a way that one of ordinary skill in the art would recognize that the applicant was in possession of the claimed genus at the time of filing.

Since the instant specification, nor the art, do not contemplate targeting a primer sequence or a portion of the antisense transcribed RNA for cleavage, one of ordinary skill in the art would not be able to practice the claimed invention without undue experimentation.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy H. Bowman whose telephone number is 571-272-0755.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

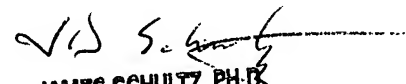
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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Amy H. Bowman  
Examiner  
Art Unit 1635

  
JAMES SCHULTZ, PH.D.  
PRIMARY EXAMINER